



Atty. Dkt. No. 023032-0108

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Joseph ROBERTS et al.  
Title: GENETICALLY ENGINEERED  
GLUTAMINASE AND ITS USE  
IN ANTIVIRAL AND  
ANTICANCER THERAPY  
Appl. No.: 09/842,628  
Filing Date: 4/27/2001  
Examiner: Timothy M. Brown  
Art Unit: 1648

**TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Your Petitioners, ME Medical Enzymes AG, having its principal place of business at Neugasse 44, CH-9001, St Gallen, Switzerland, and Joseph Roberts of 6 Sunturf Circle, Columbia, South Carolina, respectively, represent that they are each 50% owners of the entire right, title, and interest in and to U.S. Patent Application Serial No. 09/842,628, filed 4/27/2001, which is a continuation of U.S. Patent Application No. 08/050,482, filed 4/25/1995, by virtue of Assignments filed and recorded on 2/1/1993, on Reel/Frame 6516/0295 and 6516/0292, in the United States Patent and Trademark Office, copies of which are attached hereto as APPENDIX B. Further, your Petitioners represent that they are each 50% owners of U.S. Patent No. 6,312,939, which issued on U.S. Patent Application No. 08/050,482, filed April 25, 1995, by virtue of Assignments filed and recorded on February 1, 1993, on Reel/Frame 6516/0295 and 6516/0292, in the United States Patent and Trademark Office, a copies of which are attached hereto as APPENDIX B.

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Your Petitioners, ME Medical Enzymes AG and Joseph Roberts, hereby disclaim the terminal part of the term of any patent granted on the above identified patent application which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of U.S. Patent 6,312,939, and hereby agree that any patent so granted on the above identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent 6,312,939 shall be the same as the legal title to any patent granted on the above identified patent application, this agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioners do not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent 6,312,939 as defined in 35 U.S.C. §§154-156 and 173, in the event that U.S. Patent 6,312,939 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of U.S. Patent 6,312,939 as defined in 35 USC §§154-156 and 173, except for the separation of legal title stated above. Further, Petitioners do not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent 6,312,939, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioners' right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioners, certifies that he has reviewed the Assignments attached as APPENDIX B, and to the best of his knowledge and belief, legal title to the above identified patent application and U.S. Patent 6,312,939 rests with Petitioners, ME Medical Enzymes AG and Joseph Roberts. The undersigned declares that all

statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date 11/29/04

By 

FOLEY & LARDNER LLP  
Customer No. 22428  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

Peter G. Mack  
Attorney for Applicant  
Registration No. 26,001



SBK 41200  
**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

DATE: 05/25/93

TO:

SARAH A. KAGAN  
BANNER, BIRCH, MCKIE & MECKETT  
1001 G STREET, N.W. 11TH FLOOR  
WASHINGTON, D.C. 20001-4597

DOCKED

JUN - 1 1993

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT ASSIGNMENT PROCESSING SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT BRANCH, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231

ASSIGNOR:  
ROBERTS, JOSEPH

DOC DATE: 12/18/92

RECORDATION DATE: 02/01/93      NUMBER OF PAGES 003      REEL/FRAME 6516/0295

**DIGEST :**

ASSIGNOR DOES HEREBY ASSIGNS TO ASSIGNEE A 50% INTEREST  
(SEE RECORDS FOR DETAILS)

ASSIGNEE:  
ME MEDICAL ENZYMES AG  
A CORP OF SWITZERLAND  
NEUGASSE 44, CH-9001  
ST GALLEN, SWITZERLAND

SERIAL NUMBER      8-050482      FILING DATE      00/00/00  
PATENT NUMBER           ISSUE DATE      00/00/00

EXAMINER/PARALEGAL *Diane Russell*  
ASSIGNMENT BRANCH  
ASSIGNMENT/CERTIFICATION SERVICES DIVISION

11 Rec'd 10/PTO 01 FEB 1993

08/050482 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Joseph Roberts et al ) Attn: Assignment Branch  
Serial No.: To be assigned )  
(PCT/US92/10421) )  
Filed: December 4, 1992 ) Atty. Docket No. 0100.041200  
For: **GENETICALLY ENGINEERED GLUTAMINASE  
AND ITS USE IN ANTIVIRAL  
AND ANTICANCER THERAPY**

ASSIGNMENT RECORDATION LETTER

The Honorable Commissioner  
of Patents and Trademarks  
Washington, D.C. 20231

Sir:

Attached is the Assignment document of Joseph Roberts, conveying his rights, title and interest in and to the one above-referenced application to ME Medical Enzymes AG of Neugasse 44, CH-9001 St. Gallen, Switzerland which was executed on December 18, 1992 for recordal in the United States Patent and Trademark Office. Our check in the amount of \$40.00 is attached to cover the assignment recordation fee. However, if there is any variance between the amount enclosed and the Patent Office charges, please charge or credit any difference to our Deposit Account No. 19-0733. A duplicate copy of this sheet is attached for this purpose.

Please forward all communications regarding the request to record this Assignment document to the undersigned attorney-of-record.

170 WP 05/25/93 08050482

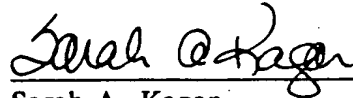
1 581 40.00 CK

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RECEIVED 16 FEB 1993

To the best of my knowledge and belief, the information contained herein is true and correct.

Respectfully submitted,




Sarah A. Kagan  
Registration No. 32,141

Banner, Birch, McKie & Beckett  
1001 G Street, N.W., Eleventh Floor  
Washington, D.C. 20001-4597  
(202) 508-9100

Date: February 01, 1993

FILED 6516 MAR 29 1993

REF 6516 FRANK 297

  
 \_\_\_\_\_  
 Notary Public  
 My Commission Expires: My Commission Expires Aug 11, 2009  
 My Commission Expires: \_\_\_\_\_

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Assignment Division  
Joseph ROBERTS et al. : BOX ASSIGNMENTS  
Serial No.: 08/050,482 : Attorney Docket No. 23032/106  
Filed: April 25, 1995  
For: GENETICALLY ENGINEERED GLUTAMINASE AND ITS  
USE IN ANTIVIRAL AND ANTICANCER THERAPY

CERTIFICATE UNDER 37 C.F.R. 3.73(b)

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Joseph Roberts, an inventor, certifies that he is the assignee of 50 percent of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventors of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

B. ☒ A chain of title from the inventors of the patent application identified above to the current assignees as shown below:

1. From: Thomas W. MacAllister, Natarajan Sethuraman, and Abbie G. Freeman To: Joseph Roberts

The document was recorded in the Patent and Trademark Office at Reel 6516, Frame 292, or for which a copy thereof is attached.

2. From: Joseph Roberts To: ME MEDICAL ENZYMES AG

The document conveyed 50 percent of the right, title, and interest and was recorded in the Patent and Trademark Office at Reel 6516, Frame 295, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.



[X] Copies of Assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above, and, to the best of the undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and, further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: October 28, 1998

Name: Joseph Roberts

Title: Inventor and Owner

Signature: *Joseph Roberts*



SHK 71200  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

DATE: 05/25/93

TO:

SAPA A. KAGAN

BANNER, BIRCH, MCKIE & BECKETT

1001 G STREET, N.W 11TH FLOOR

WASHINGTON, D.C. 20001-4597

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ASSIGNOR:  
MAC ALLISTER, THOMAS W.

DOC DATE: 11/19/92

ASSIGNOR:  
SETHURAMAN, NATARAJAN

DOC DATE: 11/19/92

ASSIGNOR:  
FREEMAN, ABBIE G.

DOC DATE: 11/19/92

RECORDATION DATE: 02/01/93      NUMBER OF PAGES 003      REEL/FRAME 6516/0292

DIGEST :ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE:  
ROBERTS, JOSEPH  
6 SUNTURF CIRCLE  
COLUMBIA, SC 29223

SERIAL NUMBER      8-050482      FILING DATE      00/00/00  
PATENT NUMBER           ISSUE DATE      00/00/00

EXAMINER/PARALEGAL  
ASSIGNMENT BRANCH  
ASSIGNMENT/CERTIFICATION SERVICES DIVISION  
*Dean Russ*

11 Rec'd PCT/PTO

FEB 1992

08/050,482

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Joseph Roberts et al

Serial No.: To be assigned  
(PCT/US92/10421)

Filed: December 4, 1992

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Attn: Assignment Branch

Atty. Docket No. 0100.041200

For: **GENETICALLY ENGINEERED GLUTAMINASE  
AND ITS USE IN ANTIVIRAL  
AND ANTICANCER THERAPY**

ASSIGNMENT RECORDATION LETTER

The Honorable Commissioner  
of Patents and Trademarks  
Washington, D.C. 20231

Sir:

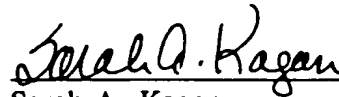
Attached is the Assignment document of Thomas W. Mac Allister, Natarajan Sethuraman and Abbie G. Freeman, conveying their rights, title and interest in and to the one above-referenced application to Joseph Roberts of 6 Sunturf Circle, Columbia, South Carolina 292223, United States of America which was executed on November 19, 1992 for recordal in the United States Patent and Trademark Office. Our check in the amount of \$40.00 is attached to cover the assignment recordation fee. However, if there is any variance between the amount enclosed and the Patent Office charges, please charge or credit any difference to our Deposit Account No. 19-0733. A duplicate copy of this sheet is attached for this purpose.

9167-6057

REEL 6516 FRAME 292

☺ To the best of my knowledge and belief, the information contained herein is true and correct.

Respectfully submitted,



☺ Sarah A. Kagan  
Registration No. 32,141

☺ Banner, Birch, McKie & Beckett  
1001 G Street, N.W., Eleventh Floor  
Washington, D.C. 20001-4597  
(202) 508-9100

Date: February 01, 1993

REC-6516 FRN 293

## ASSIGNMENT

WHEREAS, WE, Thomas W. MacAllister, citizen of the United States of America, residing at 308 E. Meadow Court, Columbia, South Carolina 29210; Natarajan Sethuraman, citizen of India, residing at 1340 Long Creek Drive #713, Columbia, South Carolina 29210; and Abbie G. Freeman, citizen of the United States of America, residing at 1538 Lonsford Road, Columbia, South Carolina 29206, having jointly invented along with Joseph Roberts, citizen of Canada, certain new and useful improvements in GENETICALLY ENGINEERED GLUTAMINASE AND ITS USE IN ANTIVIRAL AND ANTICANCER THERAPY for which an application for Letters Patent will be filed in the U.S. receiving office of the Patent Cooperation Treaty on or before December 4, 1992; and

WHEREAS, Joseph Roberts, citizen of Canada, residing at 6 Sunnurf Circle, Columbia, South Carolina 29223, is desirous of acquiring the entire right, title and interest in and to the aforesaid invention and in and to any Letters Patent of the United States or any foreign country which may be granted therefor;

NOW THEREFORE, for good and valuable consideration, we, the said Thomas W. MacAllister, Natarajan Sethuraman, and Abbie G. Freeman, by these presents do sell, assign, and transfer unto Joseph Roberts, his successors, legal representatives and assigns, our full and exclusive right to the said invention as described in the said application, and our entire right, title and interest in and to any and all Letters Patent which may be granted therefor in the United States and its territorial possessions and in any and all foreign countries and in and to any and all divisions, reissues, continuations and extensions thereof;

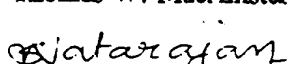
AND WE HEREBY authorize and request the Commissioner of Patents and Trademarks or any other proper officer or agency of any country to issue all said Letters Patent to said assignee;

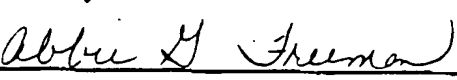
AND WE HEREBY warrant and covenant that we have full right to convey our entire interest herein assigned and that we have not executed and will not execute any instrument or assignment in conflict herewith;

AND WE HEREBY agree to communicate to said assignee or his representatives any facts known to us respecting said invention, to execute all divisional, continuation, reissue and foreign applications, sign all lawful documents and make all rightful oaths relating to said invention, and to testify in any judicial or administrative proceeding and generally do everything possible to aid the said assignee to obtain and enforce said Letters Patent in the United States or any foreign country when requested so to do by said assignee.

IN WITNESS WHEREOF, we have hereunto set our hand and seal.

Date: 11/19/92 Inventor:   
Thomas W. MacAllister

Date: 11/19/92 Inventor:   
Natarajan Sethuraman

Date: 11/19/92 Inventor:   
Abbie G. Freeman

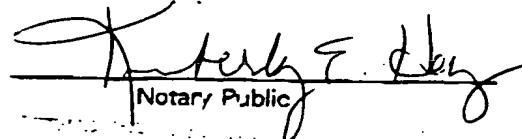
STATE OF SOUTH CAROLINA )  
COUNTY OF LEXINGTON ) ss

On this 19TH day of NOVEMBER, 1992, before me a Notary Public in and for the County and State aforesaid, personally appeared Thomas W. MacAllister, Natarajan Sethuraman, and Abbie G. Freeman to me known and known to me to be the persons of those names, who signed and sealed the foregoing instrument, and acknowledged the same to be their free act and deed.

(SEAL) RECORDED  
PATENT AND TRADEMARK  
OFFICE

FEB - 1 1993

My Commission Expires: \_\_\_\_\_

  
Notary Public

FILED 6516 MAR 29 1993